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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,894	03/24/2004	Robert H. Rines	RIN001-US	5351

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EXAMINER
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MOSSER, KATHLEEN MICHELE

ART UNIT	PAPER NUMBER
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3715

NOTIFICATION DATE	DELIVERY MODE
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12/06/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@vernmaine.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/807,894	<b>Applicant(s)</b> RINES, ROBERT H.	
	<b>Examiner</b> Kathleen Mosser	<b>Art Unit</b> 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 4/29/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/11/2010</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3715

### **DETAILED ACTION**

In response to the amendment filed 01/11/2010, a copy of which was filed 04/29/2010, claims 1-38 have been cancelled; claims 39-75 are pending. Applicant states that no amendments to the claims have been since the previous presentation of claims 1-38.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim limitation of printing coded indicia on pages of a book, "but in no fixed xy location on the pages" is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 39-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not reasonable teach how indicia on pages of a book are printed in the book "but in no fixed xy location on the pages", since printed indicia on a substrate is inherently fixed and not capable of being moved.

Art Unit: 3715

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 39-44, 46-52 and 54-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blume (US 2004, 0023200).**

Regarding claims 39, 46, 47, 58-59, and 62, Blume discloses a system and method for supplementing the materials of various passages of different printed book descriptive materials, with visual and supplemental materials, related to the specific subject matter of the passages of printed descriptive materials (see ¶ 20), that comprises, electronically storing on tracks of a recorded storage medium pluralities of the visual and audio supplemental information (See ¶ 34), and each provided with accessing coding specific to each such track of the medium; printing on the pages of the book alongside each of the various descriptive material passages, and an electronically readable code indicia corresponding specifically to that coded track of the medium containing the recorded specific visual/audio supplemental material (see ¶ 28); providing an electronic wand 14 for remotely selectively accessing the respective tracks of a medium player available to the book reader, and controlling the visual/audio playing of the same

Art Unit: 3715

for displaying/reproducing to the reader said supplemental visual information recorded on the respective tracks; and further providing to the book reader an electronic reader (optical scanner 34) of said coded indicia, adapted to actuate the electronic wand to playback respective coded tracks of the medium in the player in accordance with the book reader applying the electronic indicia reader to the respective code indicia in the book (See ¶ 23-24), thereby providing the book reader with audio/video supplemental material while reading. Blume does not explicitly disclose that the electronically readable track-identifying code indicium is in no fixed x/y location on the pages. However, Blume suggests that the electronically readable code indicia should be applied in the book to the unprinted margins or spaces of the book pages near the corresponding printed passages (See ¶ 28, 32). Thus, Blume does not limit the location of the readable code indicia to one particular position. Therefore, it would have been obvious to one of ordinary skill in the art to modify the readable code indicia described in Blume by locating them in various x/y locations in book pages, in order to correspond to the code indicia to a particular passage.

Regarding claims 40 and 48, Blume discloses electronically readable code indicia applied in the book to the unprinted margins or spaces of the book pages near the corresponding printed passages. (See ¶ 28, 32).

Regarding claims 41 and 49, Blume discloses a method wherein the book reader's application of the electronic code indicia reader 34 to a selected book coded indicia automatically actuates the wand 14 in turn to actuate the player to select and play the respective recorded track on the medium corresponding to the book reader's selected book indicia. See ¶ 23-24.

Art Unit: 3715

Regarding claims 42 and 50, Blume discloses a portable, hand-held electronic reader 34 in wired communication with the wand 14, and the wand is in wired, remote or wireless communication with the player. See ¶ 21.

Regarding claims 43 and 51, Blume discloses an electronic reader 34 and wand 14 that are integrally packaged. See Fig. 4.

Regarding claims 44 and 52, Blume discloses an electronic reader 14 provided with the book 12. See Fig. 1.

Regarding claim 54, Blume discloses that the reader 34 and the wand 14 are packaged in the form of a hand-held stylus. See Fig. 4.

Regarding claims 59 and 62, Blume discloses that the reader communication to the player of reader-selected indicia is effected by the reader initiating electronic reading of the indicia and communication thereof to the player. See ¶ 23-24.

Regarding claim 60, Blume discloses that the player is remote from the reader and the communication is wireless. See ¶ 21 and 37.

Regarding claim 63, Blume discloses that the indicia reading is effected by electronic scanning by the written material reader. See ¶ 23-24.

Regarding claim 64, Blume discloses a storage medium playback system that is remote from but visible to the reader of the written material, and the communication thereto is wireless. See ¶ 21 and 37.

Regarding claims 65, Blume discloses a storage medium comprising CD, CD player and display screen 54. See ¶ 35.

Art Unit: 3715

Regarding claim 66, Blume discloses various storage medium systems, including DVD. See ¶ 35.

Regarding claim 67, Blume discloses wherein the storage medium playback system comprises computer-accessible web storage and display screen. See ¶37.

Regarding claim 68, Blume discloses wherein the storage medium playback system comprises a computer 40 with internal storage and playback capability upon a display screen 54. See ¶ 34.

Regarding claim 55, Blume discloses a longitudinal shaped tool 14, but does not explicitly state that the tool is storable with the book. However, it is the examiner's position that it would have been obvious to one of ordinary skill in the art to store stylus 14 described in Blume with the book, since the book and stylus are utilized together.

Regarding claim 56, Blume discloses a hand-held tool that is connected by a cord to the book. See ¶ 21.

Regarding claim 57, Blume discloses a tool that is detachably connectable to the book. See ¶ 21.

Claims 69-75 are rejected for the same reasons set forth in the rejection of claims 39-44, 46-52 and 54-68.

**Claims 45 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blume (US 2004, 0023200) in view of Williams et al. (US 5,899,700; hereinafter Williams).**

Regarding claims 45 and 53, Blume discloses optical scanner 34 and describes it as being similar to bar code readers and other optical scanning devices that are well known. See ¶ 28. Although implied, Blume does not explicitly disclose that the coded indicia comprise

Art Unit: 3715

barcodes. However, Williams teaches a method and apparatus for providing multimedia material in response to a user scanning barcodes of a book. See Williams, col. 3, lines 3-27. Thus, in view of Williams, it would have been obvious to modify the optical scanner and coded indicia described in Blume, by providing coded indicia in the form of barcodes, in order to retrieve supplemental multimedia information for a book.

### ***Response to Arguments***

Applicant's arguments filed 01/11/2010 have been fully considered but they are not persuasive.

Applicant firstly asserts that the specification is enabling for the feature of "no fixed xy location on the page". Though the specification teaches that the location of the "electronically readable track-identifying code indicia" are printed at locations on the page that are "apposition or near to the specific passage(s) text material" this does not show how the printed item can not have any fixed xy location. Once the item is printed that item is at a fixed location on the page, there is no disclosure of the item being movable upon its printing. Though the specification does able designing the page layouts such that these codes could occur in several locations on the page, upon printing they are fixed to that location. Further, one of ordinary skill in the art will recognize that both printer and computer monitors (the alternative embodiment of the invention) use a matrix based system for the outputting of information. Therefor in order to print or display the information, the code must have a xy co-ordinate associated therewith. The specification as originally filed fails to show any different effect is achieved, as once the item is printed on the paper it is not movable.

With respect to the rejections under 35 USC §103, the applicant makes several assertions that the invention of the prior art and that of the instantly pending claims are different. In the making these assertions the applicant has failed to show how the language of the claims defines over the features of the prior art being cited against the claims. For example, the applicant asserts in the second full paragraph of page 8, that the "machine-readable coordinate grid is not Applicant's claimed code indicia", well addressing the element of the claims relating to a system for supplementing the materials of various



Art Unit: 3715

passages of different printed books. The code indicia are irrelevant to this passage. Both the instant invention and that of Blume allow a user to access additional audio and/or video output related to printed materials. The applicant continues by asserting that the recording system of Blume fails to include "tracks". Here the applicant is again arguing features which are not recited in the claims, citing portions of the specification in an attempt to narrowly define the claims. The system of Blume, which stores the additional content in a memory system, includes the recording on tracks. Within a computer memory system, such as the ROM disclosed by Blume, each memory address is analogous to a track. Applicant's remarks continue through the remainder of the limitations of claim 1, stating that the prior art features are in "distinct contrast" to those of the pending claims, but failing to show the nature of the difference. With respect to the repeated assertions that the "invisible" grid of Blume is not the same as the applicant's "conspicuous, visible, coded indicia", this argument centers are features which are not present in the claim. The claim only requires "an electronically readable track-identifying code indicia". There is no requirement that the reader be capable of reading the mark or that the mark be conspicuous. For the reasons stated above, the arguments are deemed non-persuasive and the rejection of the claims is maintained.

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3715

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/  
Primary Examiner, Art Unit 3715

December 1, 2010